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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,770	04/11/2001	Carlos De La Huera	250591.90279	2242
7590	01/10/2006			
Michael A. Jaskolski Quarles & Brady, LLP 411 East Wisconsin Avenue Milwaukee, WI 53202			EXAMINER MISKA, VIT W	
			ART UNIT 2841	PAPER NUMBER

DATE MAILED: 01/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/832,770	Applicant(s) DE LA HUERGA, CARLOS	
	Examiner Vit W. Miska	Art Unit 2841	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-153 is/are pending in the application.
- 4a) Of the above claim(s) 12-14, 16, 18-21, 30-32, 34, 35, 37-106 and 109-153 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 15, 17, 22-29, 33, 36, 107, 108 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. With respect to the use of the Yarin patent as a reference against some of applicant's claims, applicant notes support for the subject matter of the claims in prior application S.N. 09/185,137, of which this application is a continuation-in-part. Specifically, regarding claim 1, applicant refers to the last paragraph of the detailed description of the patented application for support for "RF memory devices and sensors". Col. 32 lines 24-26 of the patented application suggest: "The memory device or memory strip could also communicate with the processor of the container via RF technology." In addition reference is made to col. 29, line 50 of the patented application U.S. patent 6,259,654: "Information 80 is also communicated to the processor 120 and memory 60, 125 via electrical contacts or via an RF or magnetically coupled link." No further details are set forth in support of this modification.

2. The determination of whether applicant is entitled to the benefit of the filing date of a prior U.S. application is governed by 35 U.S.C. 120:

"An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously

filed application shall have the same effect, as to such invention, as though filed on the date of the prior application..."

Specifically, the description requirement of the first paragraph of 35 USC 112 must be met in the prior application for any subject matter for which the priority date is sought. "The fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. See, e.g., *Vas-Cath, Inc.*, 935 F.2d at 1563-64, 19 USPQ2d at 1117." (MPEP 2163), or whether the claims contain subject matter which was described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

3. Claim 1 of the present application recites a container having a "sensor for receiving the specifying information via radio frequency technology when the memory device is adjacent thereto". The statement in the patented application that the "memory device or memory strip could also communicate with the processor of the container via RF technology" at best suggests that the memory device and the processor have some type of RF communication means. Numerous RF communication devices exist in the prior art, and the prior specification makes no mention of a "sensor" operating "via radio frequency technology" as now claimed. U.S. Patent 6,259,654 corresponding to S.N. 08/185,137 has reference to sensors 115,281,374 etc. which are attached to the cap of a medicine container or some other supporting surface of the container for the purpose of providing electrical contact with memory

device 60 located in the container for receiving data therefrom. However, no radio frequency technology is suggested for these sensors. The statement in the patented application that “the memory device or memory strip could also communicate with the processor of the container via RF technology” suggests numerous possibilities for such modification without suggesting to one of ordinary skill in the art that applicant was contemplating an RF sensor for this modification. For example, memory 60 and processor 120 could communicate directly via internal RF circuitry without an RF sensor of the type claimed.

4. In addition, the subject matter of claims 3-10 and 15 setting forth details of the RF sensor and sensing area is absent from the parent application disclosure.

5. Consequently, the subject matter of claim 1 and claims depending therefrom are not entitled to the priority date of application 09/185,137.

6. Claims 27-29 and 33 do not set forth subject matter which was described in the prior application in a manner to convey to one skilled in the art that applicant had possession of the invention at the time of filing thereof. Specifically, the prior specification or drawings lack reference to a “horizontal sensor surface” of the sensor, or to the containers including “at least one essentially downward facing surface, the specifying devices are attached to the downward facing surfaces” of claim 27. The statement appearing in the last paragraph of the prior application suggests that “the

container could be a tray or cassette that does not include a cap, cover or lid". While the structure now claimed possibly could be included in the implementation of the suggested modification, the description does not convey to one of ordinary skill in the art the suggestion that applicant in fact contemplated this specific construction. It is apparent that the suggested modification could be realized in other ways, for example with the bar code (specifying device) arranged on the side of the containers or vials. Further, if RFID specifying devices were used, these do not require a specific location on the containers, as now claimed. Applicant argues that Figs. 31-34 in the parent patent provide support for the subject matter claimed. However, the embodiment of Figs. 31-34 lacks a "horizontal sensor surface" as claimed, but includes vertical sensor surface 940. The suggestion at col. 32, line 26 of the patent lacks reference to a specific sensor structure or a horizontal surface thereof. Regarding claim 33, no scanning operation is suggested or implied in the prior disclosure. RF circuitry may be of the continuous reception type, without scanning features.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 2841

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-11, 15, 17, 27-29 and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by Yarin et al. The reference discloses a medication system for performing health safety functions including containers 34 for holding doses of medication, the containers having RF memory device 50 containing specifying information useable to determine a prescribed dosing regimen for the medication (see col. 7, lines 39ff and col. 9, lines 7ff), RF sensors 41 (antennae) defining sensing areas 36 for receiving the specifying information, processor 40 receiving the specifying information to identify a prescribed dosing regimen (col. 9, lines 7-20), communication device 36 or 36' (Fig. 13), timing device inherently associated with processor 40 (see also col. 10, line 60) and

necessary to produce the time alerts for the medication, the processor causing the communication means 36 to indicate predetermined times, col. 10, line 66, horizontal sensor surface 30, container 34 with downward surface 34a and RF tag 50 attached thereto, aligners 32 for distinguishing sensing and non-sensing sections.

8. Claims 22 and 107 are rejected under 35 U.S.C. 102(a) as being anticipated by Glynn. The reference discloses a medication system for performing at least one health safety function including containers 1,2,4 having specifying devices 3,5,7, respectively containing specifying information (medicine identity information, col. 4, line 39), sensor 11,13 defining sensor area of tray 9 capable of receiving several specifying devices at the same time and corresponding specifying information, processor 21 receiving the specifying information read by the sensor (i.e. the identity of the container medication) to identify a prescribed dosing regimen and performing a health safety function described at col. 5, lines 16ff, i.e. prompting the user to take the medication.

9. Applicant's arguments that in Glynn the processor does not receive specifying information from the specifying devices has been noted but is not convincing in view of the application of the reference elements as noted above. Processor 21 receives the specifying information regarding identity of the container and medication therein by identifying the position of the container and the corresponding container. The fact that

the device needs to be programmed prior to use does not detract from the functioning thereof as set forth in the claims. All software based systems require some programming prior to use.

10. Claims 22-26, 107 and 108 are rejected under 35 U.S.C. 102(b) as being anticipated by Mucciacciaro. The latter reference discloses a medication system with containers 4 with specifying devices 15,16 containing specifying information (the shape of the devices identifying the particular container), sensors 6 defining sensing areas 13,14 etc. for identifying the containers, and processor 7 for identifying a dosing regimen and performing a health safety function of prompting the user to take the medication (col. 3, lines 10ff), communication devices including separate visual indicators 12 indicating the medication to be consumed, the processor including timing device 9 to determine when the time for taking each medication occurs (see Fig. 8 and col.3, lines 7-13).

11. Applicant's remarks are again directed to the lack of a sensor for receiving the specifying information. As noted above with respect to the Glynn reference , Mucciacciaro discloses sensors 6 and processor 9 for identifying the vials placed on the sensing areas. The identity of the vials thus determines the medication regimen fro the medication in the dial. Again, the programming of the device prior to use is not germane to the application of the reference to applicant's claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 23-26 and 108 are further rejected under 35 U.S.C. 103(a) as being unpatentable over Glynn in view of Mucciacciaro. The Glynn reference has been described above and includes the claimed elements except for the communication means indicating the containers. It appears that the user is informed of which medication to take by means of output display 33. It would be obvious for one of ordinary skill in the art having both references, at the time the invention was made, to provide a visual warning indicator in the Glynn system for identifying each container, as done in the Mucciacciaro device at 12, as an obvious means for prompting the user to take the medication in the correct container.

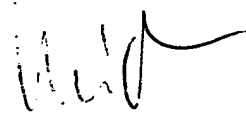
THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vit W. Miska whose telephone number is 571-272-2108. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, K. Cuneo can be reached on 571-272-1957. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Vit Miska
Primary Examiner

VM

1/6/2006